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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,825	06/12/2001	Craig W. Barnett	INVE0010-5	4591
31518	7590	04/25/2011	EXAMINER	
NEIFELD IP LAW, PC 4813-B EISENHOWER AVENUE ALEXANDRIA, VA 22304			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3682	
			NOTIFICATION DATE	DELIVERY MODE
			04/25/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/879,825	BARNETT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Arthur Duran	3682	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 47, 57 and 64-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 47, 57, 64-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/29/11</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

Claims 47, 57, 64-73 have been examined.

### ***Response to Amendment***

The Amendment filed on 8/16/2010 is sufficient to overcome the prior rejection. However, a new 103 rejection has been made. Also, please note the BPAI Decision on Appeal dated 8/21/2008 where the rejection of 09/879,825 was Affirmed-In-Part.

### ***Interference***

As noted in 7/6/10 Interview, there are no more interference requests or issues with this case.

### **Claim Rejections - 35 USC § 112**

The 112 rejection concerning a "a particular network address" no longer applies. Applicant's claim amendments dated 3/18/11 fixed 112 issues concerning this feature and the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 47, 57, 64-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over VonHohorn (5,227,874) in view of Saigh (5,734,823) in view of Cameron (5,592,378).

Independent Claims 68, 47, 57, 71:

Von Kohorn discloses a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data (Figs. 1, 3);

wherein said memory defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23; claim 6; Figs. 33, 34; claim 27);

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records (3:55-65; 2:20-30; Fig. 32; 3:30-37),

(2) information regarding coupons redeemed (2:20-30);

(3) data indicating which of said available coupon offers are to be offered (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23);

said server system programmed to respond to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification, a particular network address, and identification of a particular one of said available coupon offers, by transmitting from said server system to said particular network address, data defining a particular coupon (3:30-37; 2:65-4:3; 2:20-30; 85:15-57),

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification (3:30-36); and

said server system being programmed to respond to receipt from a coupon redemption address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed (2:20-27).

In further regards to claim 47, 57, wherein said electronic coupon includes data uniquely identifying the coupon relative to all other coupons transmitted by said first server system (2:20-30; 3:30-37; 85:15-57).

Also, on 8/16/10, Applicant made comments as to how Applicant states these claims can be interpreted, "In accordance with the present invention, the marketing analysis, coupon packaging, and coupon package distribution functions carried out by the coupon distributor 16 may be carried out at the central data repository, i.e. Internet web site. Further, the coupon redemption and user redemption information processing functions individually carried out by the coupon redemption center 13 and the individual retail stores 10 may be combined into a single redemption center, as shown by the dotted line in FIG. 1. . . The claims now pending reflect the server centric embodiment in which the redemption center also performs web site and database functions (via

limitations added to independent claims 47 and 57), which limitations also appear in new independent claims 66 and 69.”

Hence, Applicant states that the claims can be interpreted as the functions of coupon distribution, analysis, and redemption all occurring at a central location or website.

Von Kohorn does not explicitly disclose electronic forwarding of the coupon or electronic redemption of the coupon. Von Kohorn does not explicitly disclose wherein said coupon is an electronic coupon and said person presenting said coupon does so by transmitting said coupon over a network. However, Von Kohorn discloses electronic sending of coupon related information that is also related to redemption (40:10-15). Also, Von Kohorn discloses that the response unit and a central computer are electronically connected over a network (Fig. 1, 3) and also several means for how the cumulative record data can be collected (claim 8, 9; 102:5-20; and, matrix in Specification). And, Von Kohorn discloses that the analyzing and tabulating can be performed by "computerized processing and analyses" (9:3-8; 9:33-40). Hence, as shown, Von Kohorn states that analyzing/tabulating/etc can be performed by a computer. And, the MPEP states that automating a manual activity is obvious (MPEP 2144.04.III). And, Saigh discloses electronic redemption of coupons (14:15-15:10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's electronic redemption of coupons to Von Kohorn's electronic coupon information and Von Kohorn's redemption of coupons at the merchant (8:43-50). One would have been motivated to do this in order to better allow

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shoppers to use and redeem coupons. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In further regards to claim 47, 57, Von Kohorn further discloses a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system (Von Kohorn for the multiple computers, 94:30-45; Von Kohorn for the detecting, 90:60-91:20; 92:30-60; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20 ), said second server system further being adapted to redeem said electronic coupon (Saigh, 14:15-15:10). Also, note in the Applicant's stated interpretation above, the servers are all coming from the same central station/website. And, Von Kohorn discloses several computers at the central station (94:30-45) and, Saigh discloses computers functioning as servers (Figs. 1, 3).

Additionally , in the Remarks dated 3/18/11 on pages 2-6, Applicant states that the prior art does not render obvious electronic issuing and redemption of coupons.

However, the prior art combination does render obvious electronic issuing and redemption of coupons.

Firstly, Examiner notes that the electronic redemption of coupons is minimally described with minimal features in the Applicant's Specification ([31, 76]). Hence, how or the specifics of electronic coupon redemption are open to a broad interpretation.

However, Von Kohorn discloses the structure for two way communication between the end user device and the place of redemption (BPAI affirmed on 8/3/10 on pages 5, 6 in related case 09/451,558). See Figs. 29, 31 of Von Kohorn and the following.

Von Kohorn discloses a central computer/main server and a separate response unit/client computer. Figure 1 of Von Kohorn discloses a Central Station 12 in communication with a Response Unit 22. This Central Station 12 of Von Kohorn functions as the Appellant's claimed central computer/main server system. And, the separate Response Unit 22 of Von Kohorn, which is communication with the central station, functions as the Appellant's claimed client computer. Figure 28 of Von Kohorn further discloses a Central Station 828. And, importantly, Figure 30 and 26 of Von Kohorn discloses Response Unit item 800 which has a Computer item 804.

Also, note that the central station of Von Kohorn functions as a central computer/main server system and has a computer and processing and data (Fig. 29, items 202, 902, 904; and following citation):

"In terms of construction of the system 900, the data facility 904 may be located distant from the central station, or may be located on site with the central station 202. Also, the scoring computer 902 and the evaluation unit 808 may be located at sites distant from both the central station 202 and the data facility 904 or, alternatively, either



one or both of the computer 902 and the evaluation unit 808 may be located at the central station 202 or the data facility 904.” (94:30-45).

Hence, Von Kohorn discloses a central station/ central computer/ main server system in communication with a response unit/client computer (Figs. 1, 3 and citations and discussion above). Hence, Von Kohorn discloses the different client and central computers and also structure of the claims. And, this is important to understanding Appellant’s other objections.

Also, Von Kohorn further discloses two way communication between the central station and response unit (Figs. 1, 3, 22, 29, 30, 31; 90:60-91:45). The Central Station clearly sends data to the Response Unit (Fig. 3, the Central Station has a Transmitter 74 sending to a Receiver 82 or 40 which is connected to the Response Unit 22). Also, the Response Unit sends data to the Central Station. Note in Fig. 22, 29, 30, 31 that the Response Unit has a keyboard and is connected to the Central Station via the network for two way communication. For example, in Figure 31, the Central Station 202 is connected to the Play Station 206c/Response Unit. The Play Station/Response Unit receives data from the Central Station and in response the Play Station/Response Unit sends its user inputs to the Data Facility 938. And, the Data Facility is in communication with the Central Station 202. Also, note, as shown above, that the data facility can be located at/with the central station (94:30-45). Hence, the Central Station sends data to the Response Unit and the Response Unit sends data to the Central Station. Hence, there is two way communication between the Central Station/central computer/main server system and Response Unit/client computer.

This two way communication is also shown in Figure 29 of Von Kohorn. Von Kohorn discloses that the Play Station of Fig. 29 (Fig. 29, item 206) can be a Response Unit (89:41-46, "With reference to FIGS. 29-31, the operation of the system 900 begins with the preparation of data, at block 930 (FIG. 31), to be presented to a player at a playing station 206C, via block 932, and to be inputted to the response unit 800 at the playing station 206C via block 934" (col 89, lines 41-46). And, Von Kohorn discloses that there is a communication link between the Redemption Facility (item 906 corresponds to the Point of Sale System), the Data Facility (item 904), the Central Station (item 202) and the Response Unit (item 206c). Note that there is a two way communication link between these parts. Therefore, the Response Unit has a communication link with the Redemption and Authenticate Facility (Point of Sale System) by way of the two way communication links between these listed items as demonstrated in Fig. 29 (Fig. 29). Also, note, as shown above, that the data facility and redemption facility and central station can all be combined (94:30-45). Also, this interpretation of Von Kohorn has already been affirmed by the BPAI (see BPAI decision on related case 09/451,558 dated 8/3/10 page 6).

Hence, of critical import, Von Kohorn show a separate central station/central computer/main server system and client computer. And, Von Kohorn shows that the central computer and client computer are separate and are in two way communication.

Von Kohorn explicitly discloses electronic issuing of coupons (affirmed by CAFC in related cases 09/754,378 and 09/543,735). The CAFC affirmed electronic issuing of coupons in the independent claims of CAFC affirmed rejections with Von Kohorn in

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view of Saigh for 09/754,378 and 09/543,735. Also, the CAFC indirectly affirmed the electronic redemption of coupons via claims dependent claims 86 and 108, respectively. These dependent claims 86 and 108 claim electronic redemption of coupons and the CAFC affirmed the rejection of Von Kohorn in view of Saigh on all claims.

Von Kohorn does not explicitly disclose remote electronic coupon redemption. However, Von Kohorn discloses remote redemption of coupons by mail or phone (87:55-65, "...The coupon provides a discount for selected products, and may carry advertising. At block 846, the shopper transmits the coupon to a redemption center by any one of a variety of ways, such as, by mail or by telephone or in person. Then, at block 848, the shopper redeems the coupon and receives an award such as a discount on the purchase of a selected product."). Hence, given the architecture described above for two way electronic communication, it is obvious that Von Kohorn could take advantage of Von Kohorn's architecture and perform remote coupon redemption via the electronic architecture of Von Kohorn's Fig. 29, 31. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper.

Alternatively, Saigh further discloses Saigh discloses the coupon is an electronic coupon:

"Coupling to merchants' terminals promotional system provides local merchants and the local business direct access to update their promotions and coupons". (8:1-7);

“It distributes promotional and commercial information in electronic format and users may either view the digitized promotional and commercial information at the site or download the information to their personalized media for later viewing. User's can access the promotional and commercial information including the dynamic viewing electronically of advertising, available discounts, commercials, special promotional events, software demos and product catalogs” (14:15-30);

“The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand, virtual shopping, catalog sales, demos, subscription orders, electronic applications of credit cards, calling cards, or other types of services.” (14:60-67).

Hence, Saigh discloses promotions, coupons, discounts that are electronic or Saigh discloses the coupon can be an electronic coupon.

Also, Saigh further discloses the electronic redemption of coupons:

#### “4. Promotional Delivery System

The promotional system is a point of delivery system for promotional and commercial information. It distributes promotional and commercial information in electronic format and users may either view the digitized promotional and commercial information at the site or download the information to their personalized media for later viewing. User's can access the promotional and commercial information including the dynamic viewing electronically of advertising, available discounts, commercials, special promotional events, software demos and product catalogs. **Users may even shop electronically by manipulating the promotional and commercial information and**

**placing orders through E-Mail from a personal reader/computer or by ordering directly from an interactive promotional Book Bank.**” (14:15-30);

“The promotional Book Bank allows selective downloading of promotional and commercial information to the user's point of rental media (see discussion in Section B, System Architecture, for explanation of such downloading) for the user's private review and personal shopping at his convenience. . .The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand, virtual shopping, catalog sales, demos, subscription orders, electronic applications of credit cards, calling cards, or other types of services.” (14:50-67).

Hence, as shown above, Saigh discloses, “Users may even shop electronically by manipulating the promotional and commercial information and placing orders through E-Mail from a personal reader/computer or by ordering directly from an interactive promotional Book Bank” and “selective downloading of promotional and commercial information to the user's point of rental media for the...user's personal shopping at his convenience. . .The user may order products or information electronically via the network”.

Hence, Saigh discloses that electronic promotions/coupons can be downloaded and then used during electronic shopping and virtual shopping. And, using an electronic coupon during electronic shopping and virtual shopping functions as redeeming a coupon. Using a coupon during shopping constitutes redeeming a coupon. Hence, Saigh discloses the electronic redemption of electronic coupons.

Hence, Saigh does disclose the coupon is an electronic coupon and also the electronic redemption of coupons. Also, the CAFC affirmed rejections with Von Kohorn in view of Saigh for 09/754,378 and 09/543,735. This CAFC affirmation affirmed the Von Kohorn and Saigh combination for Saigh's use of the Internet related to Von Kohorn's coupon features. Hence, it is obvious that Saigh's use of Internet can be applied to Von Kohorn's coupon redemption to that Von Kohorn's users can redeem coupons using an electronic network like the Internet. Or, as shown with the features from Saigh above, it is obvious that Saigh's virtual shopping with promotions and coupons can be combined with Von Kohorn so Von Kohorn can use or redeem coupons electronically via a network. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper.

Alternatively, Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and redeeming coupons electronically via a network (Figs. 13, 15; 11:10-15). Examiner notes that the use of Cameron for these features is already affirmed by the BPAI in this case 09/879,825 (see BPAI decision for 09/879,825 dated 8/21/2008 pages 31-34 and page 37, "The Appellant's have not otherwise shown prejudicial error"). Cameron further discloses electronically using or redeeming coupons via a network (12:10-40; 20:5-20; 8:5-10; 9:40-45). Therefore, it would be obvious that Von Kohorn can utilize the electronic redemption of coupons via a network as shown in Cameron. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper. Alternatively, it would have been

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obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Dependent Claims 64, 66, 69, 72. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to store whether said particular coupon has been redeemed in said database (2:20-30).

Dependent Claims 65, 67, 70, 73. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed (2:20-30; and the forgery, authentication, validation protections of 90:60-91:20; 92:30-60; 94:13-20; 95:3-10; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20).

Claims 47, 57, 64-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over VonHohorn (5,227,874) in view of Cameron (5,592,378).

Independent Claims 68, 47, 57, 71:

Von Kohorn discloses a server system including a computer processor, associated memory, an input for receiving data, and an output for outputting data (Figs. 1, 3);

wherein said memory defines a database;

wherein said database stores coupon offer data defining available coupon offers, user record data defining user records, and targeting criteria applicable to said user records to determine which of said available coupon offers to associate with which of said user records (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23; claim 6; Figs. 33, 34; claim 27);

wherein each one of said user records stores

(1) a user identification that is different from all other user identifications stored in all other records of said user records (3:55-65; 2:20-30; Fig. 32; 3:30-37),

(2) information regarding coupons redeemed (2:20-30);

(3) data indicating which of said available coupon offers are to be offered (2:65-4:3; 3:31-37; 105:65-106:10; 105:15-23);

said server system programmed to respond to receipt over a network of a coupon request prompt, said coupon request prompt including a particular user identification, a particular network address, and identification of a particular one of said available coupon offers, by transmitting from said server system to said particular network address, data defining a particular coupon (3:30-37; 2:65-4:3; 2:20-30; 85:15-57),

wherein said data defining said particular coupon encodes both said particular user identification and said particular one of said available coupon offers, wherein said first coupon offer is a coupon offer associated in said database with said particular user identification (3:30-36); and



said server system being programmed to respond to receipt from a coupon redemption address of coupon redemption data indicating an attempt to redeem said particular coupon by comparing said coupon redemption data with said information regarding coupons redeemed in said database, to thereby determine whether said particular coupon was previously redeemed (2:20-27).

In further regards to claim 47, 57, wherein said electronic coupon includes data uniquely identifying the coupon relative to all other coupons transmitted by said first server system (2:20-30; 3:30-37; 85:15-57).

Also, on 8/16/10, Applicant made comments as to how Applicant states these claims can be interpreted, "In accordance with the present invention, the marketing analysis, coupon packaging, and coupon package distribution functions carried out by the coupon distributor 16 may be carried out at the central data repository, i.e. Internet web site. Further, the coupon redemption and user redemption information processing functions individually carried out by the coupon redemption center 13 and the individual retail stores 10 may be combined into a single redemption center, as shown by the dotted line in FIG. 1. . . The claims now pending reflect the server centric embodiment in which the redemption center also performs web site and database functions (via limitations added to independent claims 47 and 57), which limitations also appear in new independent claims 66 and 69."

Hence, Applicant states that the claims can be interpreted as the functions of coupon distribution, analysis, and redemption all occurring at a central location or website.

Von Kohorn does not explicitly disclose electronic forwarding of the coupon or electronic redemption of the coupon. Von Kohorn does not explicitly disclose wherein said coupon is an electronic coupon and said person presenting said coupon does so by transmitting said coupon over a network. However, Von Kohorn discloses electronic sending of coupon related information that is also related to redemption (40:10-15). Also, Von Kohorn discloses that the response unit and a central computer are electronically connected over a network (Fig. 1, 3) and also several means for how the cumulative record data can be collected (claim 8, 9; 102:5-20; and, matrix in Specification). And, Von Kohorn discloses that the analyzing and tabulating can be performed by "computerized processing and analyses" (9:3-8; 9:33-40). Hence, as shown, Von Kohorn states that analyzing/tabulating/etc can be performed by a computer. And, the MPEP states that automating a manual activity is obvious (MPEP 2144.04.III). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add electronic redemption of coupons to Von Kohorn's electronic coupon information and Von Kohorn's redemption of coupons at the merchant (8:43-50). One would have been motivated to do this in order to better allow shoppers to use and redeem coupons. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In further regards to claim 47, 57, Von Kohorn further discloses a second server system connected to said communications channel, said second server system being adapted to establish a connection with said client system and for detecting said electronic coupon stored on said client system (Von Kohorn for the multiple computers, 94:30-45; Von Kohorn for the detecting, 90:60-91:20; 92:30-60; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20 ). Also, note in the Applicant's stated interpretation above, the servers are all coming from the same central station/website. And, Von Kohorn discloses several computers at the central station (94:30-45).

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Von Kohorn discloses a central computer/main server and a separate response unit/client computer. Figure 1 of Von Kohorn discloses a Central Station 12 in

communication with a Response Unit 22. This Central Station 12 of Von Kohorn functions as the Appellant's claimed central computer/main server system. And, the separate Response Unit 22 of Von Kohorn, which is communication with the central station, functions as the Appellant's claimed client computer. Figure 28 of Von Kohorn further discloses a Central Station 828. And, importantly, Figure 30 and 26 of Von Kohorn discloses Response Unit item 800 which has a Computer item 804.

Also, note that the central station of Von Kohorn functions as a central computer/main server system and has a computer and processing and data (Fig. 29, items 202, 902, 904; and following citation):

"In terms of construction of the system 900, the data facility 904 may be located distant from the central station, or may be located on site with the central station 202. Also, the scoring computer 902 and the evaluation unit 808 may be located at sites distant from both the central station 202 and the data facility 904 or, alternatively, either one or both of the computer 902 and the evaluation unit 808 may be located at the central station 202 or the data facility 904." (94:30-45).

Hence, Von Kohorn discloses a central station/ central computer/ main server system in communication with a response unit/client computer (Figs. 1, 3 and citations and discussion above). Hence, Von Kohorn discloses the different client and central computers and also structure of the claims. And, this is important to understanding Appellant's other objections.

Also, Von Kohorn further discloses two way communication between the central station and response unit (Figs. 1, 3, 22, 29, 30, 31; 90:60-91:45). The Central Station

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clearly sends data to the Response Unit (Fig. 3, the Central Station has a Transmitter 74 sending to a Receiver 82 or 40 which is connected to the Response Unit 22). Also, the Response Unit sends data to the Central Station. Note in Fig. 22, 29, 30, 31 that the Response Unit has a keyboard and is connected to the Central Station via the network for two way communication. For example, in Figure 31, the Central Station 202 is connected to the Play Station 206c/Response Unit. The Play Station/Response Unit receives data from the Central Station and in response the Play Station/Response Unit sends its user inputs to the Data Facility 938. And, the Data Facility is in communication with the Central Station 202. Also, note, as shown above, that the data facility can be located at/with the central station (94:30-45). Hence, the Central Station sends data to the Response Unit and the Response Unit sends data to the Central Station. Hence, there is two way communication between the Central Station/central computer/main server system and Response Unit/client computer.

This two way communication is also shown in Figure 29 of Von Kohorn. Von Kohorn discloses that the Play Station of Fig. 29 (Fig. 29, item 206) can be a Response Unit (89:41-46, "With reference to FIGS. 29-31, the operation of the system 900 begins with the preparation of data, at block 930 (FIG. 31), to be presented to a player at a playing station 206C, via block 932, and to be inputted to the response unit 800 at the playing station 206C via block 934" (col 89, lines 41-46). And, Von Kohorn discloses that there is a communication link between the Redemption Facility (item 906 corresponds to the Point of Sale System), the Data Facility (item 904), the Central Station (item 202) and the Response Unit (item 206c). Note that there is a two way

communication link between these parts. Therefore, the Response Unit has a communication link with the Redemption and Authenticate Facility (Point of Sale System) by way of the two way communication links between these listed items as demonstrated in Fig. 29 (Fig. 29). Also, note, as shown above, that the data facility and redemption facility and central station can all be combined (94:30-45). Also, this interpretation of Von Kohorn has already been affirmed by the BPAI (see BPAI decision on related case 09/451,558 dated 8/3/10 page 6).

Hence, of critical import, Von Kohorn show a separate central station/central computer/main server system and client computer. And, Von Kohorn shows that the central computer and client computer are separate and are in two way communication.

Von Kohorn explicitly discloses electronic issuing of coupons (affirmed by CAFC in related cases 09/754,378 and 09/543,735). The CAFC affirmed electronic issuing of coupons in the independent claims of CAFC affirmed rejections with Von Kohorn in view of Saigh for 09/754,378 and 09/543,735. Also, the CAFC indirectly affirmed the electronic redemption of coupons via claims dependent claims 86 and 108, respectively. These dependent claims 86 and 108 claim electronic redemption of coupons and the CAFC affirmed the rejection of Von Kohorn in view of Saigh on all claims.

Von Kohorn does not explicitly disclose remote electronic coupon redemption. However, Von Kohorn discloses remote redemption of coupons by mail or phone (87:55-65, "...The coupon provides a discount for selected products, and may carry advertising. At block 846, the shopper transmits the coupon to a redemption center by

any one of a variety of ways, such as, by mail or by telephone or in person. Then, at block 848, the shopper redeems the coupon and receives an award such as a discount on the purchase of a selected product.”). Hence, given the architecture described above for two way electronic communication, it is obvious that Von Kohorn could take advantage of Von Kohorn's architecture and perform remote coupon redemption via the electronic architecture of Von Kohorn's Fig. 29, 31. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper.

Alternatively, Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and redeeming coupons electronically via a network (Figs. 13, 15; 11:10-15). Examiner notes that the use of Cameron for these features is already affirmed by the BPAI in this case 09/879,825 (see BPAI decision for 09/879,825 dated 8/21/2008 pages 31-34 and page 37, "The Appellant's have not otherwise shown prejudicial error"). Cameron further discloses electronically using or redeeming coupons via a network (12:10-40; 20:5-20; 8:5-10; 9:40-45). Therefore, it would be obvious that Von Kohorn can utilize the electronic redemption of coupons via a network as shown in Cameron. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same

function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Dependent Claims 64, 66, 69, 72. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to store whether said particular coupon has been redeemed in said database (2:20-30).

Dependent Claims 65, 67, 70, 73. Von Kohorn further discloses the system of claim 66 wherein said server system is programmed to disallow redemption of said particular coupon if said comparing indicates that said particular coupon was previously redeemed (2:20-30; and the forgery, authentication, validation protections of 90:60-91:20; 92:30-60; 94:13-20; 95:3-10; also, note that what applies to the card can apply to coupons 94:1-14, 90:60-91:20).

### ***Response to Arguments***

Please note the BPAI Decision on Appeal dated 8/21/2008 where the rejections were affirmed in part. Also, Examiner notes that, subsequent to the BPAI decision, the Applicant filed an RCE on 10/7/2008. Hence, the affirmation of the rejection of those features is now part of the case history on this application.

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection. Please note the addition of Cameron (5,592,378) above. Please note the 103 rejection with Von Kohorn in view of Saigh in view of Cameron above. Also, please note the complete rejection with Von Kohorn in view of Cameron above. Also, please note the following.



In the Remarks dated 3/18/11 on pages 2-6, Applicant states that the prior art does not render obvious electronic issuing and redemption of coupons.

Firstly, Examiner notes that the electronic redemption of coupons is minimally described with minimal features in the Applicant's Specification ([31, 76]). Hence, how or the specifics of electronic coupon redemption are open to a broad interpretation.

However, Von Kohorn discloses the structure for two way communication between the end user device and the place of redemption (BPAI affirmed on 8/3/10 on pages 5, 6 in related case 09/451,558). See Figs. 29, 31 of Von Kohorn and the following.

Von Kohorn discloses a central computer/main server and a separate response unit/client computer. Figure 1 of Von Kohorn discloses a Central Station 12 in communication with a Response Unit 22. This Central Station 12 of Von Kohorn functions as the Appellant's claimed central computer/main server system. And, the separate Response Unit 22 of Von Kohorn, which is communication with the central station, functions as the Appellant's claimed client computer. Figure 28 of Von Kohorn further discloses a Central Station 828. And, importantly, Figure 30 and 26 of Von Kohorn discloses Response Unit item 800 which has a Computer item 804.

Also, note that the central station of Von Kohorn functions as a central computer/main server system and has a computer and processing and data (Fig. 29, items 202, 902, 904; and following citation):

"In terms of construction of the system 900, the data facility 904 may be located distant from the central station, or may be located on site with the central station 202.

Also, the scoring computer 902 and the evaluation unit 808 may be located at sites distant from both the central station 202 and the data facility 904 or, alternatively, either one or both of the computer 902 and the evaluation unit 808 may be located at the central station 202 or the data facility 904.” (94:30-45).

Hence, Von Kohorn discloses a central station/ central computer/ main server system in communication with a response unit/client computer (Figs. 1, 3 and citations and discussion above). Hence, Von Kohorn discloses the different client and central computers and also structure of the claims. And, this is important to understanding Appellant’s other objections.

Also, Von Kohorn further discloses two way communication between the central station and response unit (Figs. 1, 3, 22, 29, 30, 31; 90:60-91:45). The Central Station clearly sends data to the Response Unit (Fig. 3, the Central Station has a Transmitter 74 sending to a Receiver 82 or 40 which is connected to the Response Unit 22). Also, the Response Unit sends data to the Central Station. Note in Fig. 22, 29, 30, 31 that the Response Unit has a keyboard and is connected to the Central Station via the network for two way communication. For example, in Figure 31, the Central Station 202 is connected to the Play Station 206c/Response Unit. The Play Station/Response Unit receives data from the Central Station and in response the Play Station/Response Unit sends its user inputs to the Data Facility 938. And, the Data Facility is in communication with the Central Station 202. Also, note, as shown above, that the data facility can be located at/with the central station (94:30-45). Hence, the Central Station sends data to the Response Unit and the Response Unit sends data to the Central Station. Hence,

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there is two way communication between the Central Station/central computer/main server system and Response Unit/client computer.

This two way communication is also shown in Figure 29 of Von Kohorn. Von Kohorn discloses that the Play Station of Fig. 29 (Fig. 29, item 206) can be a Response Unit (89:41-46, "With reference to FIGS. 29-31, the operation of the system 900 begins with the preparation of data, at block 930 (FIG. 31), to be presented to a player at a playing station 206C, via block 932, and to be inputted to the response unit 800 at the playing station 206C via block 934" (col 89, lines 41-46). And, Von Kohorn discloses that there is a communication link between the Redemption Facility (item 906 corresponds to the Point of Sale System), the Data Facility (item 904), the Central Station (item 202) and the Response Unit (item 206c). Note that there is a two way communication link between these parts. Therefore, the Response Unit has a communication link with the Redemption and Authenticate Facility (Point of Sale System) by way of the two way communication links between these listed items as demonstrated in Fig. 29 (Fig. 29). Also, note, as shown above, that the data facility and redemption facility and central station can all be combined (94:30-45). Also, this interpretation of Von Kohorn has already been affirmed by the BPAI (see BPAI decision on related case 09/451,558 dated 8/3/10 page 6).

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Alternatively, Saigh further discloses Saigh discloses the coupon is an electronic coupon:

“Coupling to merchants' terminals promotional system provides local merchants and the local business direct access to update their promotions and coupons”. (8:1-7);

“It distributes promotional and commercial information in electronic format and users may either view the digitized promotional and commercial information at the site or download the information to their personalized media for later viewing. User's can access the promotional and commercial information including the dynamic viewing electronically of advertising, available discounts, commercials, special promotional events, software demos and product catalogs” (14:15-30);

“The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand, virtual shopping, catalog sales, demos, subscription orders, electronic applications of credit cards, calling cards, or other types of services.” (14:60-67).

Hence, Saigh discloses promotions, coupons, discounts that are electronic or Saigh discloses the coupon can be an electronic coupon.

Also, Saigh further discloses the electronic redemption of coupons:

#### “4. Promotional Delivery System

The promotional system is a point of delivery system for promotional and commercial information. It distributes promotional and commercial information in electronic format and users may either view the digitized promotional and commercial information at the site or download the information to their personalized media for later viewing. User's can access the promotional and commercial information including the dynamic viewing electronically of advertising, available discounts, commercials, special

promotional events, software demos and product catalogs. **Users may even shop electronically by manipulating the promotional and commercial information and placing orders through E-Mail from a personal reader/computer or by ordering directly from an interactive promotional Book Bank.**" (14:15-30);

"The promotional Book Bank allows selective downloading of promotional and commercial information to the user's point of rental media (see discussion in Section B, System Architecture, for explanation of such downloading) for the user's private review and personal shopping at his convenience. . .The user may order products or information electronically via the network. Some of the promotional functions are: coupons on demand, virtual shopping, catalog sales, demos, subscription orders, electronic applications of credit cards, calling cards, or other types of services." (14:50-67).

Hence, as shown above, Saigh discloses, "Users may even shop electronically by manipulating the promotional and commercial information and placing orders through E-Mail from a personal reader/computer or by ordering directly from an interactive promotional Book Bank" and "selective downloading of promotional and commercial information to the user's point of rental media for the...user's personal shopping at his convenience. . .The user may order products or information electronically via the network".

Hence, Saigh discloses that electronic promotions/coupons can be downloaded and then used during electronic shopping and virtual shopping. And, using an electronic coupon during electronic shopping and virtual shopping functions as

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redeeming a coupon. Using a coupon during shopping constitutes redeeming a coupon. Hence, Saigh discloses the electronic redemption of electronic coupons.

Hence, Saigh does disclose the coupon is an electronic coupon and also the electronic redemption of coupons. Also, the CAFC affirmed rejections with Von Kohorn in view of Saigh for 09/754,378 and 09/543,735. This CAFC affirmation affirmed the Von Kohorn and Saigh combination for Saigh's use of the Internet related to Von Kohorn's coupon features. Hence, it is obvious that Saigh's use of Internet can be applied to Von Kohorn's coupon redemption to that Von Kohorn's users can redeem coupons using an electronic network like the Internet. Or, as shown with the features from Saigh above, it is obvious that Saigh's virtual shopping with promotions and coupons can be combined with Von Kohorn so Von Kohorn can use or redeem coupons electronically via a network. One would be motivated to do this to better redeem in "a variety of ways" (Von Kohorn 87:55-65) and in a way that is more convenient to the shopper.

Alternatively, Cameron discloses using the Internet or a network (5:13-16; Fig. 2) and redeeming coupons electronically via a network (Figs. 13, 15; 11:10-15). Examiner notes that the use of Cameron for these features is already affirmed by the BPAI in this case 09/879,825 (see BPAI decision for 09/879,825 dated 8/21/2008 pages 31-34 and page 37, "The Appellant's have not otherwise shown prejudicial error"). Cameron further discloses electronically using or redeeming coupons via a network (12:10-40; 20:5-20; 8:5-10; 9:40-45). Therefore, it would be obvious that Von Kohorn can utilize the electronic redemption of coupons via a network as shown in Cameron. One would

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### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Aa) Ginter 20050177716 and Burke 5,848,399 disclose relevant features to electronic coupon redemption;

a) Saigh (5,734,823) discloses many relevant features for electronic coupons and websites and electronic coupon issuing and redemption.

b) and Deaton discloses many relevant coupon features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Namrata Boveja can be reached on (571) 272-8105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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4/20/11